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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,984	06/15/2006	Jordi Tormo i Blasco	5000-0177PUS1	8776
2292 7590 03/06/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
MOORE, SUSANNA				
ART UNIT		PAPER NUMBER		
1624				
NOTIFICATION DATE		DELIVERY MODE		
03/06/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/582,984

Applicant(s)

TORMO I BLASCO ET AL.

Examiner

SUSANNA MOORE

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/92)
Paper No(s)/Mail Date 4/4/07, 5/14/07, 6/15/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claim Objections

Claim 13 is objected to because of the following informalities: claim 13 is missing a period. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10 and 15-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites, the “formula I” according to claim 2,” but claim 2 does not have a formula I. Thus, claim 15 is vague. The same situation occurs in claims 16-20.

Claim 10 recites, the “formula I according to claim 2,” but claim 2 does not have a formula I. Thus, claim 15 is vague.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmitt et. al. (U.S. 7329663 B2).

The instant Application claims compounds of formula (I) as fungicides, wherein X= alkyl, R²= hydrogen and R¹= isopropylamino.

Schmitt et. al. discloses compounds of formula (I) as anticancer agents and discloses fungicides, wherein X= chloro, R²= hydrogen and R¹= isopropylamino. See column 66, lines 4-5, example 34 and column 2, lines 46-48. The compositions are found on page 3, paragraph 0058 and the method of use can be found on page 3, paragraph 0056.

The difference between the compounds in the reference and the instant invention is the substitution at X= chloro versus Applicant's alkyl.

The genus of formula (I) in column 3 of formula (I), lines 17-28 and column 4, lines 39-45, teaches X can be alkyl, alkoxy, haloalkoxy, cyano, among others. Thus, these substituents are alternatively useable. There are many more compounds that can be found in columns 24-33, which render said claims obvious. Moreover, there is no patentable distinction between claims drawn to compounds and claims drawn to methods of intended use.

Thus, said claims are rendered obvious by Schmitt et. al.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pfrengle et. al. (U.S. 5994360).

The instant Application claims compounds of formula (I) as fungicides, wherein X= alkyl, R² and R¹= 4-methylpiperidinyl, L¹= fluorine, L³= fluorine, L²= fluorine and the 3-position of the phenyl ring is hydrogen.

Pfrengle et. al. discloses compounds of formula (I) as fungicides, wherein X= alkyl, R² and R¹= 4-methylpiperidinyl, L¹= fluorine, L³= hydrogen, L²= fluorine and the 3-position of the phenyl ring is fluorine. See column 12, Table 1 example 13. The compositions are found in column 7, line 59, and the method of use can be found in column 7, line 59.

The difference between the compounds in the reference and the instant invention is the substitution at the 3- and 4-position of the phenyl ring, fluorine versus hydrogen.

The MPEP 2144.09 states "Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus)... are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds

possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977). There are other compounds in Table 1 which only differ by the substitution on the phenyl ring.

Thus, said claims are rendered obvious by Pfrengle et. al.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pees et. al. (U.S. 5593996).

The instant Application claims compounds of formula (I) as fungicides, wherein X= cloro, R² and R¹= 4-methylpyrrolidinyl and the phenyl ring is substituted by 2,6-difluoro.

Pfrengle et. al. discloses compounds of formula (I) as fungicides, wherein X= alkyl, R² and R¹= 4-methylpiperidinyl, and the phenyl ring is substituted by 2, 3, 6-trifluoro.

. See column 25, Table IIA, example 194. The compositions are found in column 6, line 51, and the method of use can be found in column 6, line 51.

The difference between the compounds in the reference and the instant invention is the substitution at the 3- and 4-position of the phenyl ring, fluorine versus hydrogen.

The MPEP 2144.09 states "Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus)... are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977). There are other compounds in said reference which only differ by the substitution on the phenyl ring and R¹ and R².

Thus, said claims are rendered obvious by Pfrengle et. al.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6380202 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compound in Table 1, column 11, wherein X= chloro, R² and R¹= 4,4-difluoropiperidinyl, L¹= fluorine, L²= hydrogen and L³= fluorine, L⁴= hydrogen and L⁵= fluorine is an obvious variant of the compound wherein X= cyano, R² and R¹= 4,4-difluoropiperidinyl, L¹= fluorine, L²= fluorine and L³= hydrogen, L⁴= hydrogen and L⁵= fluorine. The difference is a) the substitution at the L² position and the 6-position on the phenyl ring and b) X= chloro versus Applicant's cyano.

a) The MPEP 2144.09 states, "Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus)...are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977). This is just one of many examples that occur in Table A, pages 12-13 of the disclosure of the copending Application.

b) The genus of formula (I) on page 1 teaches X can be cyano, halogen, alkyl, haloalkyl or alkoxy, see column 2 for the definition of X. Thus, these substituents are alternatively useable. There are many more compounds that can be found in Tables 1-72 and pages 9-19, which render said claims obvious. Moreover, there is no patentable distinction between claims drawn to compounds and claims drawn to methods of intended use.

Claims 1, 4, 6-14 and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 5-8, 10 and 12-15 of copending Application No. 10594738. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compound in Table A, page 12, wherein L^1 = fluorine at the 2-position of the phenyl, L^2 = fluorine at the 4-position of the phenyl, X = methyl, R^2 = hydrogen and R^1 = n-butyl is a positional isomer of the compound wherein, L^1 = fluorine at the 2-position of the phenyl, L^2 = fluorine at the 3-position of the phenyl, X = methyl, R^2 = hydrogen and R^1 = n-butyl. The only difference is the substitution at the 4-position of the phenyl and the 3-position on the phenyl ring. The MPEP 2144.09 states, "Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus)...are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977). This is just one of many examples that occur in Table A, pages 12-13 of the disclosure of the copending Application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10579144. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compound in Table 3, page 9, wherein X = ethoxy, R^2 = hydrogen,

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R^1 = methyl and 2,4,6-trifluorophenyl is at the 6-position of the bicyclic core is a positional isomer of the compound wherein, X = ethoxy, R^2 = hydrogen, R^1 = methyl and 2,3,6-trifluorophenyl is at the 6-position of the. The only difference is the substitution at the 4-position of the phenyl and the 3-position on the phenyl ring. The same positional isomer argument provided above applies here too. Here again, this is just one of many examples that occur in Table 3, pages 9-12 of the disclosure of the copending Application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10550571. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compound on pages 23, example 2, wherein X = cyano, R^2 = hydrogen, R^1 = CH_2CCH , L^1 = fluorine, L^2 = hydrogen, L^3 = fluorine, L^4 = hydrogen and L^5 = fluorine is a positional isomer of the compound wherein X = cyano, R^2 = hydrogen, R^1 = CH_2CCH , L^1 = fluorine, L^2 = fluorine, L^3 = hydrogen, L^4 = hydrogen and L^5 = fluorine. The difference is the substitution at the L^2 and L^3 position on the phenyl ring. The positional isomer argument cited above applies here also. Another specie which renders said claims obvious is the compound wherein X = chloro. The genus of formula (I) on page 1 teaches X can be cyano, halogen, alkyl, haloalkyl or alkoxy. Thus, these substituents are alternatively useable. These compounds can be found in Table 5, pages 10 and 14-17. Here again, these are just some of the many examples that occur in the reference which renders said claims obvious. Moreover, there is

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no patentable distinction between claims drawn to compounds and claims drawn to methods of intended use.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10548690. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compound in Table 5, page 10, wherein X= chloro, R²= hydrogen, R¹= CH₂(CH₃)CHCH₂, L¹= fluorine, L²= hydrogen, L³= fluorine, L⁴= hydrogen and L⁵= fluorine is an obvious variant of the compound wherein X= cyano, R²= hydrogen, R¹= CH₂(CH₃)CHCH₂, L¹= fluorine, L²= fluorine, L³= hydrogen, L⁴= hydrogen and L⁵= fluorine. The difference is a) the substitution at the L² and L³ position on the phenyl ring and b) X= chloro versus Applicant's cyano. a) The positional isomer argument cited above applies here also. B) The genus of formula (I) on page 1 teaches X can be cyano, halogen, alkyl, haloalkyl or alkoxy. Thus, these substituents are alternatively useable. There are many more compounds that can be found in Tables 1-28 and pages 5 and 10-22, which render said claims obvious. Moreover, there is no patentable distinction between claims drawn to compounds and claims drawn to methods of intended use.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10532719. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compound in Table 1, page 9, wherein X= chloro, R²= hydrogen, R¹= CH₂CH₃, Hal= fluorine, L¹= fluorine, L²= hydrogen and L³= fluorine is a positional isomer of the compound wherein X= cyano, R²= hydrogen, R¹= CH₂CH₃, Hal= fluorine, L¹= fluorine, L²= hydrogen, L³= hydrogen and the 6-position on the phenyl ring is a fluorine. The difference is a) the substitution at the L³ position and the 6-position on the phenyl ring and b) X= chloro versus Applicant's cyano. a) The positional isomer argument cited above applies here also. B) The genus of formula (I) on page 1 teaches X can be cyano, halogen, alkyl, haloalkyl or alkoxy, see page 2 for the definition of X. Thus, these substituents are alternatively useable. There are many more compounds that can be found in Tables 1-72 and pages 9-19, which render said claims obvious. Moreover, there is no patentable distinction between claims drawn to compounds and claims drawn to methods of intended use.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSANNA MOORE whose telephone number is (571)272-9046. The examiner can normally be reached on M-F 8:00-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susanna Moore/
Examiner, Art Unit 1624

/Brenda L. Coleman/
Primary Examiner, Art Unit 1624